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### REMARKS/ARGUMENTS

Reconsideration and re-examination of Claim 1 is requested. As amended, Claim 1 defines the invention as including at least two servo-mechanisms having stationary engagement pistons disposed in stationary components of the transmission including the front end wall and the housing. The prior art cited, Korkmaz et/ al and Tsukamoto et. al. do not describe not suggest structures identical with or similar to the claim limitations. Tsukamoto et. al., the only reference applied that describe specific structure, has one stationary piston that is disposed within a stationary portion of the front end wall, and one stationary piston that is disposed in a cavity formed in the rear of the transmission case. The planetary gearset shown and partially defined in the claims thereof is the subject of United States Patent No. 5, 106, 352. This planetary gear arrangement requires significantly different friction device connections when compared to the present invention. This arrangement will not accommodate the structures defined in the present invention. As pointed out by the Examiner, Korkmaz et. al. does not specifically describe a front end wall. Accordingly a holding that the Claim as amended is invalid under 35 U.S.C. § 103 is believed to be incorrect.

Also it should be pointed out that there is no suggestion or teaching in either Korkmaz et. al. or Tsukamoto et. al. that either of these disclosures enhance or are desirable to provide the improvement ascribed thereto by the Examiner. The only teaching of this combination is found in the present invention.

A holding that combination claims are invalid based merely upon finding similar elements in separate prior art patents would be "contrary to statute and would defeat the congressional purpose in enacting Title 35.

For example, see In re Geiger Unpublished decision (12/11/86)

*"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." Judge Archer.....Judge Newman found that the*

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*applicant had shown, by evidence, that his system had superior properties not rendered obvious by the cited references.*

And, as stated in *Cornell v. Sears, Roebuck and Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 199 (Fed. Cir. 1983):

*The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made.*

A precise statement as to the impropriety of a rejection, under 35 U.S.C. § 103 is found in the opinion of the CCPA rendered in the decision of *In re Linnert*, 309 F.2d 498, 503; 135 USPQ 307, 311 (1962):

*Viewed in the light of the appellants' specification, the solution to the problem ... may seem obvious over the combined teachings of the references. Such a hindsight analysis, however, is not allowed by 35 U.S.C. § 103 which requires a comparison of the prior art and the invention as a whole at the time the invention was made.*

The CCPA went on to state:

*It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill of the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of claims, it is not the type of rejection which the statute authorizes. 35 U.S.C. § 103 is very specific in requiring that a rejection on the grounds the invention "would have been obvious" must be based on a comparison between the prior art and the subject matter as a whole at the time the invention was made.*

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In view of the above amendments and remarks, this application is believed to be  
in condition for allowance, which is herewith respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Donald F. Scherer", is written over a horizontal line.

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